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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,049	07/18/2000	Mark D. Yandell	CL000735	9668

7590

07/03/2002

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EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 07/03/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/619,049

Applicant(s)

YANDELL, MARK D.

Examiner

Suryaprabha Chunduru

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,6,8,15 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,6,8 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Applicants' response to the office action and amendment (Paper No. 9) filed on April 17, 2002 has been entered.

***Response to Arguments***

2. Applicant's response to the office action (Paper No.9) is fully considered and deemed persuasive in part.

3. With respect to the rejection made in the previous office action under provisional obviousness - type double patenting, Applicant's arguments with respect to claims 4, 6, 8, and 22-26 are considered but are found not persuasive because, Applicants indicated that they would delete the SEQ ID Nos. 85-87 of the co-pending application, but did not delete said SEQ ID. Nos. Thus the rejection will be maintained until the deletion of said SEQ ID Nos. in the co-pending application.

4. With respect to the rejection under 35 U.S.C. 102 (f) and 102 (e)/103(a) made in the previous office action, Applicants arguments are fully considered and are found not persuasive because the priority for Application No. 09/618,893 is January 12, 2000 (provisional application No. 60/175,691) and for Application No. 09/614,150 the priority claimed is October 19, 1999 (provisional application 60/160,191). The instant SEQ ID Nos. 853-855 have sequence homology (100%) with the SEQ ID Nos. 85-87 of 09/618,893 and with SEQ ID Nos. 1314-1316 of 09/614,150. Thus the priority claimed in the co-pending applicants is much earlier than the instant application. Further, the rejection under 35 USC 102(e) does not require published prior art because this rejection is a provisional-type 102(e)/103(a) rejection (see MPEP, chapter 800,

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chart I-B) in conjunction with provisional obviousness - type double patenting. Therefore, the rejection under 35 USC 102 (e)/103(a), and 102 (f) are maintained herein.

### **New Grounds of Rejection**

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4, 6, 8, 22-26 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The current claims are drawn to isolated nucleotide and polypeptides, comprising a sequence set forth in SEQ ID NO. 853-855.

Following the requirements of the Utility Guidelines (See: Federal Register: December 21, 1999 (Volume 64, Number 244), revised guidelines for Utility.), the first inquiry is whether a credible utility is cited in the specification for use of the nucleotide sequences (SEQ ID NOs. 853-855). Some of the cited utilities identified by the examiner are to use these nucleic acids as targets for developing insecticidal agents and to identify vertebrate and invertebrate orthologs. These utilities are credible.

Upon identification of credible utilities, the next issue is whether there are any well established utilities for the nucleic acids or the underlying polypeptide. No well established utilities for this specific SEQ ID NOs. 853-855 and polypeptide encoding the nucleotide sequences are identified in either the specification or in the cited prior art.

Given the absence of a well established utility, the final issue is whether substantial and specific utilities are disclosed in the specification. Here, no substantial utilities which are specific to these nucleotide sequences and polypeptide encoded by these nucleotide sequences

are identified. As noted in the utility guidelines, basic research on a product to identify properties, intermediate products which themselves lack substantial utility are all insubstantial utilities. No substantial utility is identified for these specific SEQ ID Nos. 853-855 in the specification. Further, none of the recited utilities in the specification are specific to the SEQ ID Nos. 853-855. None rely on any unique feature of these nucleic acids or polypeptide encoded by SEQ ID NOs. 853-855. Therefore, the instant claims, drawn to isolated nucleotides and encoded polypeptides comprising SEQ ID NOs. 853-855 lack patentable utility.


No claims are allowable.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 703-308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Suryaprabha Chunduru  
June 27, 2002

  
**JEFFREY FREDMAN**  
**PRIMARY EXAMINER**